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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,608	12/02/2003	Hiroyuki Kometani	380-45	3708

23117 7590 03/25/2004

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EXAMINER	
SERGENT, RABON A	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/724,608	KOMETANI ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 13-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 13-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/973,747.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 12/2/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. It is requested that applicants' amend the continuing data to reflect the status of the parent application.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 284015 in view of Nakamura et al. ('034).

EP 284015 discloses a two component polyurethane sealant comprising blocked 1,8-diaza-bicyclo(5,4,0)undecene-7 as catalyst. The reference further discloses that the blocking agent for the catalyst may be a carboxylic acid having from 2 to 18 carbon atoms. See abstract and page 4, lines 22-57.

4. Though the primary reference discloses the blocking of the catalyst with a carboxylic acid, the reference fails to specifically disclose the use of an unsaturated carboxylic acid corresponding to those of applicants. However, the use of 1,8-diaza-bicyclo(5,4,0)undecene-7

blocked with an unsaturated carboxylic acid, such as crotonic acid, as a catalyst for polyurethanes was known at the time of invention. This position is supported by Nakamura et al. at column 5, lines 1-40. Furthermore, since the blocked catalyst forms in a one to one ratio, applicants' claimed ratio limitations are considered to be met.

5. Therefore, since 1,8-diaza-bicyclo(5,4,0)undecene-7 blocked with an unsaturated carboxylic acid was a known catalyst for polyurethanes, the position is taken that it would have been obvious to utilize the catalyst of the secondary reference as the blocked catalyst within the two component polyurethane sealant of the primary reference. It has been held that it is prima facie obvious to utilize a known component for its known function. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

RABON SERGENT
PRIMARY EXAMINER

R. Sergent
March 20, 2004